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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,326	10/07/2003	Gerold Weinl	024445-399	2680

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EXAMINER	
SHEEHAN, JOHN P	

ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/679,326	WEINL ET AL.	
	Examiner	Art Unit	
	John P. Sheehan	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 August 2002*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) *6* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/31/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Interpretation

1. It is the Examiner's position that transitional term, "comprising" used in applicants' claims (claim 1, line 2) is open terminology that leaves the claims open to any unrecited elements even in major amounts, MPEP 2111.03.

> The transitional term "comprising ",which is syn - onymous with "including," "containing," or "charac - terized by," is inclusive or open--ended and does not exclude additional,unrecited elements or method steps.See,e.g.,*Genentech,Inc.v.Chiron Corp* ., 112 F.3d 495,501,42 USPQ2d 1608,1613 (Fed.Cir. 1997)("Comprising "is a term of art used in claim language which means that the named elements are essential,but other elements may be added and still form a construct within the scope of the claim.); *Moleculon Research Corp.v.CBS,Inc.*,793 F.2d 1261,229 USPQ 805 (Fed.Cir.1986);*In re Baxter* , 656 F.2d 679,686,210 USPQ 795,803 (CCPA 1981); *Ex parte Davis* ,80 USPQ 448,450 (Bd.App.1948) ("comprising " leaves "the claim open for the inclu - sion of unspecified ingredients even in major amounts ").

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1 to 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinl et al. (Weinl '590, US Patent No. 5,682,590).

Weinl '590 teaches a titanium based carbonitride alloy for use as a cutting tool (Abstract and column 1, lines 9 to 14) having a composition that appears to overlap the instantly claimed alloy (column 2, lines 7 to 30) and an example that appears to be encompassed by the instant claims (column 4, Example 1).

The claims and Weinl '590 differ in that Weinl '590 is silent with respect to the C/(C+N) ratio and the amount of undissolved Ti(C, N) cores recited in the applicants' claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy taught by the reference has a composition that is encompassed by the instant claims and is made by a process which is similar to applicants' process of making the instantly claimed alloy. In view of this, the alloy taught by the reference would be expected to posses all the same properties as recited in the instant claims, including the C/(C+N) ratio and the amount of undissolved Ti(C,N) cores recited in the applicants' claims, In re Best, 195 USPQ, 430 and MPEP 2112.01.

> "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada,15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not

necessarily possess the characteristics of the claimed product. In re Best,195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

Response to Arguments

4. Applicant's arguments filed August 31, 2006 have been fully considered but they are not persuasive.

Applicants, referring to the Table in Example 4 of the specification, state, "cutting inserts made of the cermet alloy of the present invention offer an improvement in total cutting performance as compared to known cermets". The Examiner is not persuaded. Applicants' comparison does not compare the claimed invention to the closest known prior art, Weinl, MPEP 716.02(e). In Example 4 of the specification only a single example of the claimed invention is use in the comparison set forth in the Table. In view of this, the alloy composition in the Table representing the instantly claimed invention is not commensurate in scope to the claimed invention. Accordingly, the data set forth in the Table is not persuasive, MPEP 716.02(d). Further, general superiority cannot be inferred from the results obtained using a single embodiment of the claimed invention, In re Greenfield, 197 USPQ 227, 230 and MPEP 2144.08 (B).

Applicants argue that the composition of the reference and the claims are not alike and state as an example that Weinl "discloses that the tungsten content should be much higher than herein". The Examiner is not persuaded. Applicants have not specifically and distinctly pointed the alleged differences in composition. Although in making their argument applicants refer to W, applicants have not specifically pointed out

how the W content of the claims and Weinl differ not have applicants pointed out what the basis is for their statement.

Applicants argue that to obtain the claimed amount of undissolved Ti(C, N) cores recited in the applicants' claims requires a process using 50-70 wt% of Ti(C, N) and suitable sintering temperature. The Examiner is not persuaded. Applicants have not provided any evidence to support their position. "It is well settled that unexpected results must be established by factual evidence. Mere argument or conclusory statements in the specification do not suffice." In re Deblauwe, 222 USPQ 191, 196 (Fed. Cir. 1984). Mere lawyer's arguments and conclusory statements in the specification, unsupported by objective evidence, are insufficient to establish unexpected results." In re Wood, Whittaker, Stirling and Ohta, 199 USPQ 137, 140 (CCPA 1978). Further, Weinl teaches a sintering temperature of 1400-1600^{0}C (column 3, line 35) that overlaps applicants' disclosed sintering temperature range of 1370-1500^{0}C (page 8, lines 12). Weinl also teaches a specific example sintering temperature of 1430^{0}C (column 4, line 10) that is encompassed by applicants disclosed sintering temperature range. Finally, it is pointed out that applicants' claims are not directed to a process but rather to a product.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (6:45-4:30) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John P. Sheehan
Primary Examiner
Art Unit 1742

jps